

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1, 2, 4, 8, 9, 15, 16, 18 and 20 have been amended, as set forth herein.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1, 2, 8, 9, 15, 16 and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rhee (US Patent No. 5,524,137). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant has amended independent Claims 1, 8, and 15 to recite that a “multimedia prompt” that includes a first video clip and first audio information associated with the first video clip.

The cited portion of Rhee (Col. 5, lines 4-13) differs from independent Claims 1, 8 and 15 (as amended) because Rhee describes that when the user is using a video terminal, the video terminal receives a “video prompt.” The cited portion of Rhee does not disclose a multimedia prompt including a video clip and audio information associated with the video clip. This portion of Rhee

merely contemplates and describes a video-only prompt (no audio). Rhee appears to describe that a user selects a communications format -- video or audio. Rhee, Col. 3, lines 40-44. The Office Action points to Rhee, Col. 3, lines 18-31 as describing a “video/audio prompt” provided to a caller. Applicant respectfully submits that these prompts are separate prompts - one video and one audio - and are not truly associated with each other. These prompts appear separate from each other and provided in different formats (as Rhee’s system does not appear to know the type of terminal the user is calling from). Applicant’s multimedia prompt includes a video clip and audio information associated with the video clip. Therefore, the cited portions of Rhee does not disclose or describe providing a multimedia prompt having a video clip and audio information associated with the video clip.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1, 2, 8, 9, 15, 16 and 18.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 3, 4, 12, 13, 14, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee (US Patent No. 5,524,137) in view of Lor (US Patent No. 6,201,562). Claims 5 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee (US Patent No. 5,524,137) in view of Ejima (US Patent No. 6,259,469). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee (US Patent No. 5,524,137) in view of Turak (US Patent Application Publication No. 2003/0232245). Claims 7, 11 and 17 were rejected under 35 U.S.C. §

103(a) as being unpatentable over Rhee (US Patent No. 5,524,137) in view of Golasinski (US Patent Application Publication No. 2003/0097332). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

As set forth above, Rhee fails to disclose one or more elements recited in independent Claims 1, 8 and 15 (as amended). The cited portions of the secondary references do not appear to disclose, teach or suggest these one or more elements, and therefore do not cure the deficiency (ies) noted in Rhee. Therefore, the combinations of Rhee and the secondary references (as set forth in the Office Action) do not disclose, suggest or teach the claim invention.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 3-7, 10-12, 13, 14, 17, 19 and 20.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.

Date: 11/2/2007


Robert D. McCutcheon
Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: rmccutcheon@munckbutrus.com